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EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,631

Applicant(s)

KO ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

Status of Claims

2. As per the Amendment filed on 24 September 2003:

Claim 17 was cancelled.

Claims 5, 16, 18, 20, 26 were amended.

Claim 42 was added.

Claims 1-16 and 18-42 remain pending.

Response to Request for Reconsideration

3. The request for consideration filed on 24 September 2003 under 37 CFR § 1.111 has been considered but is ineffective to overcome Uranaka and Toyama, US Patent No. 5,937,158 and JP Patent No. JP407295998A, respectively..

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive and fail to overcome the references.

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On the issue of read-only versus writable medium. Uranaka states, in the description of each of his embodiments (C1, that the "media-utilizing information" (i.e. the original catalog content, the restaurant guide, etc. – content that does not need to change) will be "recorded on special-purpose area on DVD, which is different from the original recording area in DVD". Examiner interprets this as meaning: while the DVD as a whole can only be read-only or writeable, the original content shipped with the disks will always be recorded in a special area, i.e. protected from being recorded over. There is every incentive to keep original content from being accidentally written over or erased. This "special" area will always be read-only, once the disks have been manufactured and recorded by the vendor.

On the issue of the use of differing display methods for items a vendor wants to attract buyers' attention to: Examiner did not make an Official Notice in the rejection of claims 7, 8, and 21. Uranaka clear suggests that display methods may be different for different content, in order to highly selected content. Various attention drawing display methods are larger, bolder text fonts, as well as more colorful text and image displays. Thus it would have been obvious from a reading of Uranaka that color may be chosen as such a display method when a vendor wants to highlight new product versus old ones. The reference clearly teaches this.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-41** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Uranaka** in view of **Toyama**, US Patent No. 5,937,158 and JP Patent No. JP407295998A, respectively.

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As per claims 1, 5, 16, 26, and 34

Uranaka discloses

[a medium with instructions for recording/reproducing; method / system of purchasing using a catalog recorded on a medium] (Abstract, Fig 1-3, associated text), comprising:

[a medium with] a read-only area in which original commodity catalog information is written (Fig 1-2: "media-utilizing information"; Fig 12-14; C17, L17-31; associated text); and

a writeable area (Fig 1-2, 12-13, associated text);

accessing a server with corresponding catalog information (Fig 3, associated text);

receiving a request for access by a computer using the medium to the catalog information (Fig 3, associated text);

checking whether updated catalog information written on a predetermined read-only area of the medium is on the server; and transmitting the updated commodity catalog information (Fig 5, associated text).

Uranaka does not disclose that

..updated commodity catalog information is written [to the writeable area of the medium] when provided by the server.

However Uranaka teaches that user purchase information may be written to the medium (C4, L18-34; C17, L17-31); he also teaches that his invention may determine whether catalog/product/guide information on the media is old when compared to the corresponding information on the server, and if the information on the medium is outdated, then new information will be transmitted from the server to the client for display (Fig 5, C10, L12-39).

Toyama discloses a system wherein an electronic catalog supplied on portable medium may be updated or revised by writing the new data onto the medium (Abstract).

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to have added this feature (suggested by Uranaka and disclosed by Toyama) to Uranaka's system, so that a user will always be assured of being able to browse, and review the most updated product/service information prior to purchase, starting from an published portable storage medium and then comparing with corresponding content stored on a remote server. Such a system would meet all the limitations of claims 1, 5, 16, 26, and 34.

As per claim 2.

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Uranaka does not specifically disclose
.. said read only area comprises
a first area in which the original commodity catalog information as of a manufacture time of the medium is written, and
a second area in which an encrypted key of a vendor is written.

However, as noted above for claims 1, 5, 16, 26, and 34, Uranaka teaches that his system will have the capability to determine whether content on the portable medium is old or current with content on the server (Fig 5, C10, L12-39). Therefore it is obvious that such determination inherently requires that a date of manufacture would need to be encoded on the medium.

Also, Uranaka teaches that (1) the medium will have information uniquely identifying its origin (Fig 16: "DVD Identifying Information", "Title Information", "Issue Number Information", "Catalog Shopping Server Network Address", "Validity Check Value"; associated text); (2) that the medium would be uniquely certified and validated each time a request is made from the user to a server (same citations; C21, L18-22). While Uranaka does not go into the details of how all this certifying and validity checking is accomplished, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that one method for accomplishing these checks would be to use a vendor encryption key encoded onto the medium. Such a method would meet the remaining limitation of claim 2, and would be motivated by the desire to prevent unauthorized use of the content of the medium or the server.

As per claims 3 and 11.

Uranaka in view of Toyama discloses all the limitations of claims 1 and 2 respectively.

Uranaka further discloses (see all above citations; Fig 16, associated text)

..said writeable area comprises [areas]

in which commodity purchase information is written (C4, L18-34), and
for a user's private information (C4, L18-34).

Uranaka does not specifically disclose areas in which
a commodity catalog information update date is written; or
updated commodity catalog information is written.

Using the same obviousness and motivation analysis for claims 1, 5, 16, 26 and 34 above, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that any updated catalog material would inherently need to be written onto a reserved writeable area of the

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medium, in order to provide the latest, locally stored catalog information for a user after each session with the server. Furthermore, it would have also been obvious that each such update would need to be date stamped, so that the system will know when subsequent updates would need to be written again.

As per **claims 4 and 12**.

Uranaka in view of Toyama discloses all the limitations of claims 3 and 11 respectively.

Uranaka further discloses (Fig 13, 16, associated text)

...said writeable area is an area in which predetermined information is repeatedly written by the server and a user.

As per **claims 6-8, 21**.

Uranaka in view of Toyama discloses all the limitations of claims 5 and 19.

Uranaka further discloses

[claim 6] displaying the [updated] commodity catalog information (C19, L22-46).

Uranaka does not specifically disclose

[claim 7] catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other.

[claim 8] the updated portion and the nonupdated portion are marked with different colors.

[claim 21] displaying both the existing and updated commodity catalog information such that the updated commodity catalog information is distinguishable from the existing commodity catalog information.

However Uranaka discloses that different display methods may be used for items ranked higher in terms of user preference – derived from past purchase history – than lower ranked products, and also for items that have already been purchased by the user in the past, versus items not yet ordered (C19, L26-33). Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made that one further display method difference, i.e. using different colors for new items compared to old ones, would have further enhanced the user's awareness of the new additions, thus potentially creating a desire to buy the new products. Such an added display method is consistent with Uranaka's teaching, and would anticipate claims 6-8 and 21.

As per **claims 10, 19, 28**,

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Uranaka in view of Toyama discloses all the limitations of claims 5, 16, and 26 respectively.

Uranaka further discloses (see rejections of claims 1, 5, 16, 34 and claims 6-8, 21 above):

[claim 10] checking whether there is a commodity item to be updated/edited is performed through communication with the commodity information server.

[claim 19] the existing commodity catalog information has a corresponding age that is read from the medium, the updated commodity catalog information has a corresponding age that is read from the server, and said receiving the updated commodity catalog information comprises comparing the ages of the existing and updated commodity catalog information, and receiving the updated commodity catalog information where the ages are different.

[claim 28] said checking comprises comparing a first age of the existing commodity catalog information on the medium with a second age of the updated commodity catalog information on the server, and said transmitting comprises transmitting the updated commodity catalog information when the second age is less than the first age.

As per claims 9, 22-25, 27, 29-31.

Uranaka in view of Toyama discloses all the limitations of claims 5, 16, 21, 26 and 28.

Uranaka further discloses all the following limitations (Fig 14, associated text; C20 L16 – C21 L3):

[claim 9] recording a purchase order based on the retrieval of the commodity catalog information from the medium.

[claim 22] making a purchase of a commodity using the existing and/or updated commodity catalog information.

[claim 23] receiving a purchase record from the server after said making the purchase, and writing the purchase record to the writeable area of the medium.

[claim 24] making a purchase of a commodity using the existing and/or updated commodity catalog information.

[claim 25] receiving a purchase record from the server after said making the purchase, and writing the purchase record to the writeable area of the medium.

[claim 27] receiving an order for a commodity based upon the existing commodity catalog information.

[claim 29] receiving an order for a commodity based upon the updated commodity catalog information.

[claim 30] receiving an order for a commodity based upon the combined existing and updated commodity catalog information.

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[claim 31] transmitting a purchase record to be written on the medium.

As per **claims 13-14**.

Uranaka in view of Toyama discloses all the limitations of claim 1.

Uranaka further discloses

[claim 13] information is optically written (Fig 3, associated text).

[claim 14] information is magnetically written (Summary, C2, L23; C22 L62 – C23 L5).

As per **claims 15, 18, and 20**.

Uranaka in view of Toyama discloses all the limitations of claims 1, 16, and 19.

Uranaka further discloses (Fig 16, associated text) that the catalog medium of his invention will have areas where information (original catalog data, media/vendor information) will be written once and readable-only thereafter; areas where information will be written over and over (new purchase orders, updated user information, purchase history). Taking in consideration the further need to write updated catalog data onto the medium as taught by Toyama, it would have been obvious to one ordinarily skilled in the art at the time the invention was made that the following limitations would all need to be met in Uranaka's invention in order to allow for the flexibility he discloses:

[claim 15] writeable area comprises an area to which information is written once, and is thereafter a read only area.

[claim 17] existing commodity catalog information is written in a read-only area of the medium.

[claim 18] existing commodity catalog information is written in a writeable area of the medium.

[claim 20] existing commodity catalog information comprises original commodity catalog information written in a read only area of the medium, and previously updated commodity catalog information written in a writeable area of the medium.

As per **claims 32-33**.

Uranaka in view of Toyama discloses all the limitations of claims 26 and 31.

Uranaka further discloses

receiving a password from the computer (C19, L47-57; Fig 14, associated text).

Uranaka does not specifically disclose

transmitting an encrypted key to the computer based upon the password.

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However he does teach that the user needs to be uniquely certified before he can use the medium and the server, and that said certification will be based on the password chosen by the user (C19 L47 - C20 L7). The use of encrypted keys for such certification procedures is well known in the art, and therefore one ordinarily skilled in the art at the time the invention was made would have ensure that such keys are used in the invention, in order to provide strong security for transactions involving purchase orders and payments for those orders.

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As per claim 35.

Uranaka in view of Toyama discloses all the limitations of claim 34.

Uranaka further discloses

an electronic commerce server, the electronic commerce server to provide electronic commerce between said computer and said server during the purchase (Fig 12, associated text; C17 L17 - C18 L3),

Uranaka does not recite

an encryption server [with] encryption security device, to transmit an encrypted key to be written on the write area to be used if a commodity is purchased, the encryption security device and the encryption server to authenticate an identity of a user, and provide cryptographic communication between said computer and said server.

However, as analyzed in claim 33 above Uranaka does teach that the user needs to be uniquely certified before he can use the medium and the server (C19 L47 - C20 L7). The use of encrypted keys for such certification procedures is well known in the art, and therefore one ordinarily skilled in the art at the time the invention was made would have ensure that an encryption server with a security device would be included in the invention, so that cryptographic keys are used to authenticate and certify purchase orders, to prevent fraudulent use of the system.

As per claims 36-41.

Uranaka in view of Toyama discloses all the limitations of claim 35.

While Uranaka does not recite all the limitations of these claims, he clearly teaches that any well-known network and communication protocol may be used for his invention (C23 L3-5). Therefore Uranaka anticipates all the following claims:

[claim 36] the network comprises a wireless network.

[claim 37] the network comprises a network over the Internet.

[claim 38] the network comprises a local area network.

[claim 39] the network comprises a wide area network.

[claim 40] the network comprises an Ethernet network.

[claim 41] the network comprises a metropolitan area network.

As per claim 42.

Uranaka in view of Toyama discloses all the limitations of claim 1.

Uranaka further discloses

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..a write once area to which data can be written once; and
a rewriteable area to which data can be repeatedly written and/or from which data can be erased
(see citations for claims 1, 5, 16, 26, and 34; response to arguments).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL


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